

EXHIBIT 1

From: Wikberg, Terrence (WDC)
Sent: Tuesday, November 17, 2020 1:25 PM
To: Sklar, Steven; Snow, Max; Arceo, Frances; 'dpwaxman@bclplaw.com'; Fenix-Litigation; Kopinski, Nicole; Airan, David
Cc: Moffa, Matthew (NYC); Simpson, Amy (SDO)
Subject: RE: Carnegie Inst. of Wash et al. v. Fenix Diamonds LLC (SDNY No. 20-200)

Counsel:

Plaintiffs Carnegie Institution of Washington and M7D Corporation (“Plaintiffs”), on behalf of themselves and any successors-in-interest to U.S. Patent No. RE41,189 (the ’189 Patent), make the following covenant not to sue for the purpose of resolving all issues related to the ’189 Patent in this litigation between the Plaintiffs and defendant Fenix Diamonds LLC (“Fenix”).

Based on documents, images, videos, testimony, and other information produced in discovery by Fenix and its supplier Nouveau Diamonds LLP (“Nouveau”) regarding the process by which Fenix’s diamonds are annealed, and on representations made by Fenix and its supplier Nouveau throughout this litigation, Plaintiffs unconditionally and irrevocably covenant not to assert patent infringement (including direct infringement, contributory infringement, and induced infringement) against Fenix, Nouveau, or Fenix’s direct or indirect subsidiaries under any claim of the ’189 Patent based upon Fenix’s and Nouveau’s previous or current or future making, using, manufacturing, development, marketing, licensing, distributing, importing, offering for sale, or selling of any of their product(s) annealed by Nouveau’s annealing process as such process has been described by Fenix and Nouveau throughout this litigation. Plaintiffs further covenant not to sue any other Fenix supplier, distributor, customer, or partner, or any of their successors and assigns, under any claim of the ’189 Patent based upon their previous or current or future making, using, manufacturing, development, marketing, licensing, distributing, importing, offering for sale, or selling any of Fenix’s product(s) annealed by Nouveau using the Nouveau annealing process as such process has been described by Fenix and Nouveau throughout this litigation. For the avoidance of doubt, this covenant does not extend to claims of patent infringement under any patent other than the ’189 Patent.

Based on the foregoing, Plaintiffs intend to immediately make a motion with the Court to withdraw the infringement claims as to the ’189 Patent with prejudice from the present litigation. Plaintiffs requests Fenix’s position regarding the motion and Fenix’s availability for a call with the Court so that Plaintiff’s can make this application as soon as possible.

Additionally, in view of the foregoing covenant and Plaintiffs’ motion to withdraw, Plaintiffs’ ask that Fenix withdraw its counterclaims as to the 189 Patent.

To the extent Fenix wishes to meet and confer regarding this application we are generally available.

Regards

Terry

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